REMARKS

The present invention provides a method for determining the binding affinity and/or stoichiometry of a binding complex between a binding factor and a probe by measuring the fluorescence intensity resulting from laser-fluorescence polarization of the binding complex in a sample when the sample is analyzed by chromatography methods such as capillary electrophoresis to distinguish between a fluorescently-labeled probe and the binding complex containing both the probe and the factor which binds the probe.

Claims 2-4, 11-12, 16, and 24 are pending in the application. In this response claims 12 and 24 are amended and new claims 25-26 are added. Support for these amendments and new claims are found at least on pages 11 and 17 of the application.

In the Office Action issued September 17, 2008, the prior rejection of Claims 2, 11-12, 16, and 24 as being anticipated by Wan et al. (Analytical Chemistry (2000)) was withdrawn. The rejection of Claim 24 under 35 U.S.C. §112, second paragraph; the rejection of Claims 2-4, 11-12, 16, and 24 under 35 U.S.C. § 103(a); and the rejection of Claims 2, 11, 16, and 24 on the ground of non-statutory obviousness-type double patenting were maintained. Applicant respectfully submits that in view of the amendment of Claim 24 and the remarks which follow, Claims 2-4, 11-12, 16, and 24 are in condition for allowance.

Rejection of Claim 24 Under 35 U.S.C. §112, Second Paragraph

Claim 24 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It was asserted that the claim does not

refer to any laser-induced fluorescent polarization and that the claim is unclear as to step (iii). In this response claim 24 has been amended to specify that it is the fluorescence intensity of laser-induced fluorescence of the sample that is measured. In addition part (iii) of step (c) has been amended to make this step clearer. Applicant respectfully asserts that these amendments distinctly claim the subject matter of his invention and asks that the rejection of claim 24 under 35 U.S.C. § 112, second paragraph as being indefinite be withdrawn.

Rejection of Claims 2-4, 11-12, 16, and 24 under 35 U.S.C. § 103

Claims 2-4, 11-12, 16, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Laing et al. (U.S. Patent No. 6,331,392, hereafter "the Laing '392 patent") in view of Le et al. (U.S. Patent No. 6,132,968, hereafter "the Le '968 patent"). Applicant again traverses this rejection as it may apply to the present claims.

Neither the Laing '392 patent nor the Le '968 patent is prior art to the claimed subject matter of the present application, and thus may not properly form the basis of a *prima facia* case that the claims of the pending application are obvious under 35 U.S.C. § 103(a). The Laing '392 patent is not prior art to the present application because its December 18, 2001 issue date, which is its publication date, is not more than one year prior to the September 1, 2000 priority date of the present application (35 U.S.C. § 102(b)). Nor was the Laing '392 patent a printed publication in this or another country before the invention date of the Applicant of the subject matter of the present application (35 U.S.C. § 102(a)) as indicated by at least the September 1, 2000 filing date of the application from which the present application claims priority.

Moreover, the Laing '392 patent has no effective (35 U.S.C. § 102(e)) as it was filed before November 29, 2000, the effective date of the present provisions of 102(e). At the time the '392 application was filed, its disclosure was kept in confidence by the USPTO pursuant to 35 U.S.C. § 122 and there is not indication that the application was published in another country. Thus, the disclosure of the Laing application was confidential (not known to others) under the applicable law prior to the issuance of the '968 patent.

Like the Laing '392 patent, the publication date of the Le '968 patent is its issue date, October 17, 2000, which is not more than one year prior to either the September 1, 2000 or September 4, 2001 priority dates of the present application. Thus, the '968 patent is not prior art to the present application under any subsection of 35 U.S.C. § 102, and is therefore not prior art to the present application for purposes of obviousness under 35 U.S.C. § 103. Thus, the outstanding rejection of Claims 2-4, 11-12, 16, and 24 based on a combination of the teachings of the Laing '392 patent with the teachings of the Le '968 patent cannot establish a *prima facia* case of obviousness, as neither patent is prior art to the present application.

Because neither the Laing '392 patent nor the Le '968 patent are properly cited as prior art to the present application, Applicant asserts that the outstanding rejection of claims 2-4, 11-12, 16, and 24 as being obvious under 35 U.S.C. § 103(a) fails to establish a *prima facia* case of obviousness, and respectfully asks that the rejection of Claims 2-4, 11-12, 16, and 24 on this basis be withdrawn.

Non-Statutory Obviousness-Type Double Patenting Rejection of Claims 2, 11, 16, and 24

Claims 2, 11, 16, and 24 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of the Le '968 patent, in view of the Laing '392 Patent). Applicant believes that the rejection of the instant claims over the '968 patent, in view of the '392 patent, is made in error, and respectfully requests that the rejection be withdrawn. "The purpose of an obviousness-type double patenting rejection is 'to prevent an unjustified extension of the term of the right to exclude granted by a patent by allowing a second patent claiming an obvious variant of the same invention to issue to the same owner later.'" *Ex parte Whalen II et al.*, __ USPQ 2d ___, Appeal 2007-4423 at 8 (BAPI 2008) (citing *In re Berg*, 140 F. 3d 1428, 1431 (Fed. Cir. 1998). Unlike obviousness determinations under 35 U.S.C. § 103(a), which compare claimed subject matter to the prior art, nonstatutory double patenting compares claims in an earlier patent to claims in a later patent or application. *Id.* at 7-8.

In the prior response, Applicant asserted that the obviousness double patenting rejection as to the '392 patent was made in error as there is no common assignee or inventor between the present application and the Laing '392 patent. To support this position, Applicant's representative intended to refer to MPEP 804, Definition of Double Patenting, in particular to Chart II-B Conflicting Claims between an Application and a Patent, at MPEP page 800-16 of the current MPEP. The chart indicates that where an application and a patent have no common assignee or inventor and do not have a proper joint research exclusion under section 103(c), the proper rejection to be made is under section 102(e)/103(a), not a non-statutory

double patenting rejection. Here the Laing '392 patent has no common assignee or inventor and is not 102(e)/103(a) prior art, as the patent issued from an application that was filed on March 5, 1998. The Laing '392 patent does not have an effective date 102(e) as prior art. Because the Laing '392 patent does not have an effective 102(e)/103(a) date, it is not available as prior art against the present application.

Likewise, the Le '968 patent is not prior art to the present application. Like the Laing '392 patent, the Le '968 patent was filed and issued prior to November 29, 2000. Its issue/publication date, October 17, 2000, is after the September 1, 2000 priority date of the present application. For the reasons discussed above, Applicant respectfully asserts that the rejection of claims 2, 11, 16, and 24 for non-statutory obviousness-type double patenting based on the Le '968 patent, in view of the Laing '392 patent is improper and respectfully requests that the rejection for non-statutory obviousness type double patenting be withdrawn.

Conclusion

For all of the reasons set forth above, Applicant believes that claims 2-4, 11, 12, 16, and 24 are in condition for allowance and respectfully requests that each of the rejections set forth in the Office Action of September 17, 2008 be withdrawn and that a timely Notice of Allowance be issued. If the Examiner believes that prosecution of the present matter could be advanced by having a discussion with Applicant's representative, she is invited to contact the representative at (703) 838-6562.

Should any additional fees be required for this response, the Commissioner is authorized to charge deficiencies or credit any overpayment to Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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